



09-06-05

IHW

# Walker & Jocke

a legal professional association

Ralph E. Jocke  
Patent  
&  
Trademark Law

September 2, 2005

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Attn: Art Unit 3651  
Patent Examiner Leslie Nicholson III

Re: **Application No.:** 10/796,333  
**Confirmation No.:** 1994  
**Applicants:** Graef, et al.  
**Title:** Cash Dispensing Automated  
Banking Machine And Method  
**Docket No.:** D-1217 R1

Sir:

Please find enclosed Applicants' Response to the Office Action dated August 11, 2005 for filing in the above identified Application.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with this Response and any other fee due to Deposit Account 09-0428.

Very truly yours,

Ralph E. Jocke  
Reg. No. 31,029

## CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that this document and the documents indicated as enclosed herewith are being deposited with the U.S. Postal Service as Express Mail Post Office to addressee in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 this 2d day of September 2005.

EV660194217US  
Express Mail Label No.

  
Ralph E. Jocke

330 • 721 • 0000  
MEDINA

330 • 225 • 1669  
CLEVELAND



330 • 722 • 6446  
FACSIMILE

rej@walkerandjocke.com  
E-MAIL

231 South Broadway, Medina, Ohio U.S.A. 44256-2601



D-1217 R1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	)	
<b>Graef, et al.</b>	)	
	)	
Application No.: <b>10/796,333</b>	)	Art Unit 3651
	)	
Confirmation No.: <b>1994</b>	)	
	)	
Filed: <b>March 9, 2004</b>	)	Patent Examiner
	)	Leslie Nicholson III
	)	
Title: <b>Cash Dispensing Automated</b>	)	
<b>Banking Machine And Method</b>	)	

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

Reconsideration and withdrawal of the species election requirement dated August 11,  
2005 is respectfully requested.

### **The Alleged Species**

The Action alleges the following Species:

Species I: Figures 11-14.

Species II: Figure 15.

Species III: Figure 16.

Species IV: Figure 17.

Species V: Figures 2-10.

Species VI: Figures 18-21.

### **Applicants Provisionally Elect With Traverse**

In response to the Action requiring species election, Applicants, as the requirement is best understood, provisionally elect with traverse the alleged Species VI. The Office acknowledges that at least claims 1 and 17 are generic. All claims 1-27 are readable on the alleged Species VI.

Reconsideration and withdrawal of the election requirement is respectfully requested. Applicants respectfully submit that the requirement is not legally proper and should be withdrawn.

### **The Requirement is not legally proper because there is no serious burden**

MPEP § 803 sets forth criteria for a proper requirement. One of the criteria is that there must be a "serious burden" on the examiner in order for election to be required. Contrarily, if the search and examination of an entire application can be made without serious burden then the examiner must examine it on the merits. Applicants respectfully submit that the election requirement is not legally proper because the criteria for serious burden has not been met.

**The Requirement is not legally proper as a reasonable number of species are permitted**

Applicants are entitled to a reasonable number of species (i.e., more than one species). Even if it were somehow possible for the Office to show serious burden (which it hasn't), 37 C.F.R. § 1.146 still permits an application to have claims directed to a reasonable number of species. Applicants respectfully submit that even if the application had species as alleged, the alleged species would still be reasonable, especially in light of the Office's lack of any evidence to the contrary. Again, the requirement is not legally proper and should be withdrawn.

**The Requirement is not legally proper  
because a valid reason for species restriction is absent**

The “mutually exclusive characteristics” (MPEP § 806.04(f)) and the “relationship” (MPEP § 808.01(a)) of the alleged species have not been provided to Applicants. A valid reason why the alleged species are distinct species is absent in the Action.

In accordance with MPEP § 806.04(f), claims to be restricted to different species must be mutually exclusive. The "general test" as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which are found in a first species but not in a second species, while a second claim recites limitations only for the second species and not the first species. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species.

The Action has not indicated which *claim* recites limitations which are found in a first species but not in a second, while a second *claim* recites limitations disclosed only for the second species and not the first, as is required in order to meet the noted “general test” of MPEP § 806.04(f). Thus, the Action procedurally fails to present a valid reason for the requirement.

Where does the Action demonstrate that the alleged species are mutually exclusive (MPEP § 806.04(f))? For example, where does the Action show that the alleged species are prevented from being used in the same embodiment? Where does the Action provide evidence that the other alleged species are specifically prevented from be used with alleged Species VI? Where does the Action provide a reason why the alleged Species VI and each of the other alleged Species are mutually exclusive species? Likewise, where does the Action provide valid reasons of mutual exclusivity for the other alleged species. The Action has not shown that each alleged specie cannot be used in an embodiment with another alleged specie. Rather, the Action's own allegations appear to be contrary to the general test for species being mutually exclusive.

The Action must show that each of I/II, I/III, I/IV, I/V, I/VI; II/III, II/IV, II/V, II/VI; III/IV, III/V, III/VI; IV/V, IV/VI; and V/VI are mutually exclusive. The Action has not shown that the alleged species are prevented from being used in the same embodiment. The Action has not met the general test for mutually exclusive species. It follows that the Action has not met the test for a proper species restriction requirement. Thus, the requirement is improper and should be withdrawn.

Nor has the Office demonstrated where the alleged species occur in the claims, nor the common characteristic linking each of the alleged species. Applicants respectively disagree with the Actions allegations and descriptions of species. For these reasons it is respectfully submitted

that there is no valid basis for requiring species election. Thus, it is respectfully submitted that the requirement should be withdrawn.

**The Requirement is not legally proper because it is incomplete/unclear**

The Action does not meet the species restriction requirement criteria set forth in MPEP § 809.02(a). The Action does not clearly identify each of the alleged species *to which claims are restricted* in accordance with MPEP § 809.02(a). Where does the Action correspond the *claimed* subject matter to the alleged species?

The species restriction requirement does not properly describe the alleged distinct species. Nor are the alleged species clearly and properly presented. The Office has not indicated where the alleged species occur in the claims, nor the common characteristic linking the alleged species. The Action leaves Applicants the burden of properly responding to an unclear and improper requirement. Because the criteria for proper species restriction requirement has not been met by the Office, Applicants have not been given a fair opportunity to make an informed election. On this basis it is respectfully submitted that the requirement should be withdrawn.

The Action does not present a valid species restriction requirement based on the laws, rules, and Patent Office procedures. The Action at best pertains to allegations of species. The Action also appears to obfuscate the issues, because there is no proper species election requirement to be made. For these reasons it is respectfully submitted that the requirement is improper. As there is no valid basis for requiring the species election requirement, it is respectfully submitted that the requirement should be withdrawn.

Applicants, as the requirement is best understood, have provisionally elected with traverse. However, Applicants reserve all rights to change or modify their election based on the alleged species election requirement presentation being made a clearly understood and proper requirement.

### **Conclusion**

The species election requirement is respectfully traversed. The species election requirement is not proper. Therefore, it is respectfully requested that the species election requirement be withdrawn.

The undersigned is willing to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,



Ralph E. Jocke      Reg. No. 31,029  
WALKER & JOCKE  
231 South Broadway  
Medina, Ohio 44256  
(330) 721-0000